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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/301,656

04/28/1999

KINYA WASHINO

FNI-01503/03

5893

25006

7590

06/02/2008

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EXAMINER

DIEP, NHON THANH

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/301,656	<b>Applicant(s)</b> WASHINO ET AL.	
	<b>Examiner</b> Nhon T. Diep	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18, 25-38, 41-58 and 60-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 25-38, 41-58 and 60-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/28/1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Reissue Applications*

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,625,410 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

2. Claims 1-18, 25-38, 41-58 and 60-74 rejected as being based upon a defective reissue declarations under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declarations is set forth in the discussion above in this Office action.

In the declarations that were filed, none of them include the statement that the person signing the declaration acknowledges the duty to disclose to the office all information known to the person to be material to patentability as defined by 37 CFR 1.56. The statement that applicants did submit in the declarations failed to include the phrase “**as defined by 37 CFR 1.56**”.

It is also noted that once all amendments to the application are finally in allowable form, a supplemental declaration will be needed to cover any errors that were corrected since the filing of the previous declaration. The declaration must state that "Every error which was corrected in the present reissue application, and which is not covered by the prior declarations submitted in this application arose without deceptive intention on the part of the application".

3. Claims 16 is rejected as being based upon a defective reissue under 35 U.S.C. 251 as set forth below. See 37 CFR 1.175.

The nature of the defect(s) in the problem of recapture is set forth in the discussion below in this Office action. There is the problem with recapture: (a) claim scope that was canceled or amended during the original prosecution is deemed surrendered and therefore barred from reissue; and (b) a reissue claim that entirely omits any limitation that was added/argued during the prosecution to overcome an art rejection, is impermissible recapture. Based on the above analysis, we have impermissible recapture in this case.

Under the first analysis of recapture, during the prosecution of the parent application, a preliminary amendment was submitted which included an amendment to originally presented claim 1. On July 1, 1996, an Office Action was mailed which rejected claim 1 as being anticipated by Cash. Subsequently, Applicants filed an amendment on October 7, 1996 which incorporated then allowed claim 9 into claim 1. This amendment altered the system of claim 1 to now include two forms of high-capacity storage media with a further description of each. This means the original and

preliminary amendment subject matter with respect to claim 1 was surrendered by the filing of the October 7, 1996 amendment. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution. Claim 16 is directed towards a video storage system, i.e., dividing the subject matter of patent claim 1. Given that the amendments presented in the original Patent application were directed towards a computer and the high capacity storage media, then it is improper recapture for Applicants to revert back to the original and/or preliminary amendment versions of the storage media. In other words, Applicant is removing a limitation which was added in order to distinguish the claims from the prior art of record. Secondly, regarding the second analysis, Original claim 1 was directed to a video storage and display system whereby the system comprised a high-capacity storage medium. The October 7, 1996 amendment modified this limitation to now disclose two forms of high-capacity storage medium. By removing this recitation of two forms of high-capacity storage medium without adding a broader version of that limitation, constitute improper recapture.

4. The claims and the specification are not properly amended under 37 CFR 1.173(b). In the amendment to the claims 4/6/2007, any limitation that was added to the original patent claims, must always be shown as underlined. Any limitations that were deleted from the original patent claims must always be shown with brackets. It is noted that claims 1, 6, 7, 12, and 15 have all been amended but show no such underlined and/or bracketing. In the amendment to the specification (preliminary amendment filed 4/28/1999), all amendments must be done by presenting the entire paragraph where

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change is to occur and showing added language by underlined and deleted language by bracketing and also identifying the location where paragraph is to be located.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Case (US 5,481,297) as set forth in the previous Office Action (7/1/1996, notice that claim 16 is broader than the rejected claim 1).

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon T. Diep whose telephone number is 571-272-7328. The examiner can normally be reached on m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ND

/Nhon T Diep/  
Primary Examiner, Art Unit 2621